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Filing date: **10/12/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204122
Party	Defendant Michael Liang
Correspondence Address	DAVID YAN LAW OFFICES OF DAVID YAN 136-20 38TH AVENUE, SUITE 11E FLUSHING, NY 11354 4232 UNITED STATES davidyanlawfirm@yahoo.com
Submission	Other Motions/Papers
Filer's Name	David Yan
Filer's e-mail	davidyanlawfirm@yahoo.com
Signature	/David Yan/
Date	10/12/2014
Attachments	Affirmation in Opposition to Opposer's Motion for Summary Judgment.pdf(860871 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

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EMPIRE STATE BUILDING COMPANY L.L.C.,	:	Opposition No.: 91204122
	:	
Opposer,	:	
	:	
v.	:	
	:	
MICHAEL LIANG,	:	
	:	
Applicant.	:	
	:	
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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT’S AFFIRMATION IN OPPOSITION TO
THE OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

GENUINE DISPUTE AS TO THE MATERIAL FACT

Upon the annexed Declaration of Michael Liang (“Liang Decl.”) and the exhibits thereto, and the memorandum of law set forth herein, Applicant hereby requests for an order, pursuant to T.B.M.P. § 528 and Fed. R. Civ. P. 56, denying the Opposer’s motion for summary judgment in this proceeding. There is genuine dispute as to material fact that Applicant has a bona fide intention to use the mark at issue in the United States commerce at the time when he filed his intent-to-use application for registration, and Opposer is not entitled to any judgment as a matter of law.

MEMORANDUM IN SUPPORT OF MOTION

STATEMENT OF DISPUTED FACTS

In support its motion for summary judgment, Opposer relied on the erroneous translation of the Applicant's business plan written in Chinese into English, which is misleading and fraudulent. Opposer was put in notice when Opposer received the Applicant's answer to the Opposer' Amended Notice of Opposition that the translation was in error. Opposer, however, still knowingly uses such erroneous translation to support its motion for summary judgment.

Opposer's version of translation alleges that, "If [the mark] is approved, will plan to produce beer and related beverages in the United States and sell them in the China market." (Opposer's Exhibit D). The correct translation of the pertinent part of the Applicant's business plan from Chinese into English is that, "If [the mark] is approved, [we] will plan to produce beer and relevant beverages[.] [We will] sell [them] in the markets of the United States and China." This document does show a bona fide intent to use a mark in the United States commerce. As such, Opposer is not entitled to summary judgment as a matter of law.

ARGUMENT

OPPOSER HAS NOT ANY STANDING TO OPPOSE APPLICANT'S MARK

A. Opposer Makes the Motion is not the Same Party Who Filed Notice of Opposition

Opposer in the instant motion is ESRT Empire State Building, L.L.C., which is not the same party who filed Notice of Opposition on March 1, 2012. Empire State Building Company, L.L.C. is the opposer in the Notice of Opposition on March 1, 2012.

ESRT Empire State Building, L.L.C. has not made any prior motion to substitute itself as the opposer to replace initial opposer in the Notice of Opposition on March 1, 2012. The instant motion for summary judgment is not the proper form for ESRT Empire State Building, L.L.C. to

make the compound motion to substitute itself as the incoming opposer. Hence, ESRT Empire State Building, L.L.C. lacks the standing to make the instant motion.

B. Opposer Has Failed to Pass the Threshold Inquiry of Standing

Section 13 of the Trademark Act provides that an opposition to the registration of an applicant may be filed “by any person who believes that he would be damaged by the registration of a mark upon the principal register.” “Purpose in inquiring standing is to prevent litigation where there is no real controversy between the parties” and Opposer is “no more than an intermeddler”. *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 197 (C.C.P.A. 1982).

There is not any confusion on the part of any member of the public between Opposer and Applicant and/or their respective marks and/or goods or services. For instance, U.S. Registration No. 1247058 with the work mark “NY” and the designed drawing that shows a “fanciful design of the **Empire State Building**” does not confuse any part of the member of the public where the owner of the U.S. Registration No. 1247058 Mark uses the Mark in the industries or areas in Skylines; Gravestones; Leaning Tower of Pisa; Space needle; Tombstones; Totem poles; Envelopes; Rectangles as carriers or rectangles as single or multiple lien borders and where Opposer uses its Empire State Building Marks in their registered areas of providing observation decks in a skyscraper for purposes of sightseeing and managing and leasing the real estate.

Opposer’s Marks are registered in International Classes 36 and 41, namely, Registration Nos. 2411972, 2413667, 2429297 and 2430828. On the contrary, Applicant’s Mark is for International Class 32. Hence, Opposer cannot show that it has any real interest in the matter. Accordingly, the Opposer’s belief of damage, *if any*, is not support by any real or rational basis;

but is purely speculative. *See American Speech-Language-Hearing Assoc. v. Nat'l Hearing Aid Society*, 224 U.S.P.Q. 798, 801 (T.T.A.B. 1984).

Therefore, Opposer lacks the standing to make the summary judgment motion.

**APPLICANT HAS A BONA FIDE INTENT TO USE APPLICANT'S MARK
IN THE UNITED STATES COMMERCE IN CONNECTION WITH
APPLICANT'S GOODS AT THE TIME HE FILED HIS APPLICATION**

Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) dictates that, at the time an applicant files an intent to use application, he must have a bona fide intent to use the mark in commerce in connection with the goods covered by the Application.

Congress, however, in drafting the Trademark Law Revision Act of 1988 ("TLRA"), purposely omitted a statutory definition of the term "bona fide" as used in the phrase "bona fide intention," in the interest of preserving "the flexibility which is vital to the proper operation of the trademark registration system." 15 U.S.C. Section 1126(d)(2); *see also* S. Rep. No. 100-515, 100th Cong. 2d Sess. at 43 (1988) (hereinafter "S. Rep." at 24). However, the legislative history of the TLRA provides that "in connection with this bill, 'bona fide' should be read to mean a fair, objective determination of the applicant's intent based on all the circumstances," and that ". . . applicant's *bona fide* intention must reflect the good-faith circumstances surrounding the intended use." *Id*; *see also Lane Ltd. v. Jackson Int'l Trading co. et al.*, 33 U.S.P.Q.2d 1351, 1355 (T.T.A.B. 1994).

Similarly, the House report, H. Rep. No. 100-1028, 100th Cong. 2d Sess. (1988) (hereinafter "H. Rep.") provides as follows:

By permitting applicants to seek protection of their marks through an "intent to use" system, there should be no need for "token use" of a mark simply to provide a basis for an application. The use of the term "bona fide" is meant to eliminate such "token use," and to require, based on an objective view of the circumstances, a good faith intention to eventually use the mark in a real and legitimate

commercial sense. Obviously, what is [*16] real and legitimate will vary depending on the practices of the industry involved, and should be determined based on the standards of that particular industry.

H. Rep. at 8-9.

Thus, the determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances. While the determination of whether the applicant has the requisite bona fide intention is to be an objective determination, neither the statute nor the legislative history of the TLRA specifies the particular type or quantum of objective evidence that an applicant must produce to corroborate or defend its claimed bona fide intention to use the mark in commerce. In contrast, the legislative history of the TLRA provides several specific examples of objective circumstances which, if proven, “may cast doubt on the bona fide nature of the intent or even disprove it entirely.” S. Rep. at 23; *see also Lane Ltd.*, 33 U.S.P.Q.2d at 1355.

In the instant matter, Applicant has applied, in his entire life, only for the registration of the Mark, NYC BEER LAGER, Application Serial No. 85/213,453 in the United States. Applicant has never applied for the registration of any other mark. The circumstances indicate that Applicant has genuine bona fide intent to actually use the Mark in the United States commerce. Applicant’s evidence pertaining to the implementation of its business plan and licensing program constitutes credible, objective corroboration of its statement in the application that it had a bona fide intention to use the mark in commerce on beer and relevant beverages (International Class 32).

First, Applicant’s claimed bona fide intention to use his Mark in commerce on beer and relevant beverages (International Class 32) is corroborated by Applicant’s business plans. Applicant planed prior to and at his application for registration of this Mark, he and his partners

contemplated that, “If [the mark] is approved, [he and his partners] will plan to produce beer and relevant beverages[.] [he and his partners will] sell [them] in the markets of the United States and China.” His plan considered the hiring of salespersons in the United States and China. His plan also considered production and joint venture with other manufacturers to make his products on beer and relevant beverages (International Class 32). This document does show a bona fide intent to use a mark in the United States commerce.

Similarly, Applicant’s claim of bona fide intention is also corroborated, in the circumstances of this case, by his attempts to locate a U.S. licensee who could manufacture his products on beer and relevant beverages (International Class 32) under his Mark. Applicant’s declaration regarding him and his partners’ efforts in licensing his Mark with a U.S. beer brewing company located in Harlem, New York City reveals the Applicant’s bona fide intention. The U.S. beer brewing company located in Harlem, New York City produces Harlem Sugar Hill.

In short, the documentary evidence of record in this case is sufficient to establish as a matter of law that Applicant possessed the requisite bona fide intention to use its mark in commerce on beer and relevant beverages (International Class 32). Opposer has not presented, and presumably cannot present at trial, evidence of any other circumstances which might tend to cast doubt on or disprove Applicant’s claim of bona fide intention.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board: (1) deny the Opposer’s motion to substitute ESRT Empire State Building, L.L.C. for Empire State Building Company L.L.C. as Opposer; (2) deny the Opposer’s motion for summary judgment on the ground of bona fide intention to use Applicant’s Mark in connection with Applicant’s Goods at

the time that he filed his Application; and (3) granting Applicant such further and other relief as the Board deems just and proper.

Dated: Flushing, New York
October 9, 2014

Respectfully submitted,

/David Yan/
David Yan, Esq.
Attorney for Applicant / Defendant
136-20 38th Avenue, Suite 11E
Flushing, New York 11354
Telephone: (718) 888-7788

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on October 9, 2014, I caused a true and correct copy of the foregoing Applicant's Affirmation in Opposition to the Opposer's Motion and supporting Declaration of Michael Liang and with exhibits to be sent via U.S. Post First Class Mail, postage prepaid, to Opposer's Attorney of Record, William M. Borchard, Esquire, Cowan Liebowitz, & Latman, P.C., located at 1133 Avenue of the Americas, New York, NY 10278.

/David Yan/

David Yan

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

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EMPIRE STATE BUILDING COMPANY L.L.C.,	:	Opposition No.: 91204122
	:	
Opposer,	:	
	:	
v.	:	
	:	
MICHAEL LIANG,	:	
	:	
Applicant.	:	
-----	X	

**DECLARATION OF MICHAEL LIANG
IN SUPPORT OF APPLICANT'S AFFIRMATION IN OPPOSING
THE OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

Michael Liang, pursuant to 28 U.S.C. § 1746, declares:

1. I am the Applicant. I submit this declaration in support of Applicant's Affirmation in Opposition to the Opposer's motion for summary judgment. I submit this declaration based on my personal knowledge and/or review of my records, and if called as a witness, I would testify competently as to the matters contained herein.

2. On January 8, 2011, *via counsel*, I submitted application to request registration of a trademark under the serial number of 85213453 (hereinafter referred to as the "Mark"). The Applicant's Mark is NYC BEER LAGER with the drawing shown below:



for “Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed maltbased alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter” in International Class 32.

3. Prior to the submission of the application for the registration of the Mark, I and my partners John Wang and Qin Wang met on October 20, 2010 in Hangzhou City, China to discuss and form our business plan for registering the Mark, producing, marketing, and selling beers and relevant beverages with the Mark in the United States and China. We planed to form a joint venture with local brewers to produce beers and relevant beverages with the Mark. We planned to hire experienced salespersons in the United States and China to sell beers and relevant beverages with the Mark.

4. Because our targeted consumers are primarily natives and citizens of China who live in China and travel to the world, we want our Mark to reflect the atmosphere of the international metropolitan living and life style. Hence, we want our Mark to have the reference to the landmarks of the international metropolitans, such as the Eiffel Tower in France, the World Trade Center, the Empire State Building, or the Statute of Liberty in the United States.

5. We, however, have never considered selling beers and relevant beverages with the logos of the Eiffel Tower in France, the World Trade Center, the Empire State Building, or the Statute of Liberty in the United States. Actually, these logos have nothing to do with beers and relevant beverages. Using these logos will not promote the sales of beers and relevant beverages. What we wanted is the living and life style implied by these logos of the Eiffel Tower in France, the World Trade Center, the Empire State Building, or the Statute of Liberty in the United States; but not the logos themselves. I do not believe there is any likelihood of confusion among general public who will connect beers and relevant beverages with the Empire State Building, a concrete structure.

6. We have contacted many local brewers about the possible licensing the Mark by using the local brewers' production facilities and sales channels. One of such brewers is the Harlem Brewing Company located in Harlem, New York. In or about the Christmas time in the end of 2010, I and my partner John Wang approached to the Harlem Brewing Company about the possible licensing the Mark to the company to sell beers and relevant beverages using our Mark. In return, I and my partner hoped the Harlem Brewing Company would pay loyalty fees to us. Ms. Celeste Beatty was the representative to the Harlem Brewing Company. I met her at least 4 or 5 times in discussing the licensing our planned Mark prior to submitting the application for registration of the Mark and after the submission of the application for registration of the Mark on January 8, 2011. The Harlem Brewing Company has been selling beers and relevant beverages under the mark of "Suger Hill Beer Ale". I like the thick and bitter taste of the "Suger Hill Beer Ale" and believe that consumers and tourists from China will like the taste of the "Suger Hill Beer Ale" as well. "Suger Hill Beer Ale", however, does not sell well to the Chinese consumers. My advantage is that I am from China and has connection with business community

in China. There is mutual interest between the Harlem Brewing Company and me to sell beers and relevant beverages brewed by the Harlem Brewing Company by using our Mark to Chinese consumers. The Harlem Brewing Company as well as other brewers, however, does not want to license our Mark prior to the final approval of the registration of the Mark by the U.S. Patent and Trademark Office.

7. When the Opposer Empire State Building Company, L.L.C. filed opposition on March 1, 2012, our discussions with these local brewers about possible forming joint ventures to license our Mark to brew and sell beers and relevant beverages by using our Mark were ended.

8. I and my partners prepare to resume such talks with local brewers about forming joint ventures to license our Mark to brew and sell beers and relevant beverages by using our Mark to the Chinese consumers and tourists who are attracted to the international metropolitan living and life styles.

9. I and my partners have no interest or intention to cause general public to confuse our Mark with the Empire State Building, or falsely suggest a connection between our Mark and the Empire State Building, or cause a likelihood of dilution by blurring of the distinctive quality of the Empire State Building marks. For me and the general public's thinking, the Empire State Building marks are not beers and beverages. No one will connect the Empire State Building marks, a concrete skyscraper, with beers and beverages. Actually, no one will believe one can drink the Empire State Building, a concrete skyscraper.

10. In my life as well as my partners' life, this is the only Mark we have ever submitted application for registration anywhere in the world, except for one similar to this Mark that we submitted application for registration in China.

11. When I and my partners sought protection of our Mark through the “intent to use” system on January 8, 2011, we never intend for “token use” of the Mark. I and my partners actually have good faith intention to eventually use the Mark in a real and legitimate commercial sense.

I DECLARE UNDER PENALTY OF PERJURY UNDER THE LAWS OF THE UNITED STATES OF AMERICA THAT THE FOREGOING IS TRUE AND CORRECT, EXECUTED ON OCTOBER 9, 2014 IN NEW YORK, NEW YORK.

A handwritten signature in black ink, appearing to be 'Michael Liang', written over a horizontal line.

Michael Liang

EXHIBIT B

商业计划

(会议记录)

2010年10月20日

地址: 中国杭州

参会人员:

Michael Liang, John Wang, Wang Qin

内容: 计划申请一个商标在中国美国同时
申请(看一下哪一个能批准)
如果批准, 将计划生产啤酒相关饮料
在美国, 中国市场销售.

商标(Logo)的框价:

要以国际大都市的也林为设计: 如美国
曼哈顿铁塔, 美国世贸大厦, 帝国大厦, 自由女神
等标志为参照, 体现勇敢, 向上, 有理想
和梦想的意义.

市场销售:

在中美两地, 请有经验的销售人员,
华盛顿省布地区设代理, 总代理,
以其管理参考.

生产地区:

可以找当地加工厂合作, 可降低成本,
保证货源产品的质量和品质保证.

分工负责:

Michael 负责申请 Logo, 联系律师注册
John Wang 负责设计网络宣传和
广告言语修改.

Wang Qin: 负责市场销售, 生产计划
中国市场的有关合作人员.

利润分配

设. 60% 为我的三人. 其它利润为投入股本. 为 40%.

也可以: 留 10% 为公司股. 保留..

高材的交代:

可以中国的娃哈哈. 美国的哈特啤酒做参考.

附件:

此次会议. 作为三人的合作记录. 为协议起草而开会. 而确定. 三人同意合作. 如有其它事宜. 可以协商.

BUSINESS PLAN

(minutes of meeting)

October 20, 2010

Address: Hangzhou, China

Participants:

Michael Liang, John Wang, Wang Qin

Contents:

Plan to apply for [registration of] a trademark in China and the United States at the same time (to see which one can be approved).

If [the trademark is] approved, will plan to produce beer and relevant beverages[.] [Will] sell [them] in the markets of the United States and China.

Framework of Trademark (Logo):

Must make reference to international metropolitan landmarks in the design: such as the Eiffel Tower in France, the World Trade Center, the Empire State Building, [and/or] the Statue of Liberty in the United States. Reflecting the meaning of being brave, upward, having ideals and dreams.

Sales and Marketing:

In both China and the United States, hire experienced salespersons, must set up agencies and general agency in cities and provinces.

For management reference.

Production Areas:

May work with local brewers [as joint ventures], thus [can] reduce costs, guarantee the sources and products' freshness [and] quality.

Responsibilities:

Michael [Liang] is responsible for applying for [trademark] Logo, contacting lawyer(s) for registration;

John Wong is responsible for designing website promotions and modifying commercial ads' languages;

Wang Qin is responsible for marketing, sales, production, seeking for relevant partners in the China's market.

Allocation of Profits:

Set 60% [profits] for three of us. Rest of the profits is for investor shareholders at 40%.

Alternatively: reserve 10% for corporate shares.

Logo Culture:

May make reference to WaHaHa of China, Harlem beer of the United States.

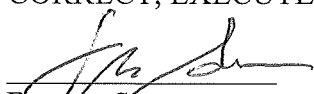
Appendix:

This meeting [minutes] is for the record of the cooperation among three of us, which [the meeting] was held for discussing and drafting an agreement. The three of us agree to work together. Need to consult with each other for other issues, *if any*.

Certificate of Translation

I, Frances Sun, am competent to translate from Chinese into English and *vice versa*, and certify that the translation of the foregoing **Business Plan** document from Chinese into English is true and accurate to the best of my knowledge and abilities.

I DECLARE UNDER PENALTY OF PERJURY UNDER THE LAWS OF THE UNITED STATES OF AMERICA THAT THE FOREGOING IS TRUE AND CORRECT, EXECUTED ON OCTOBER 9, 2014 IN FLUSHING, NEW YORK.



Frances Sun